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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,325	07/23/2003	Douglas G. Guenther	WTI0115	7745
7590 Wilson Sporting Goods Co. 8750 W. Bryn Mawr Ave. Chicago, IL 60631	12/05/2008		EXAMINER WONG, STEVEN B	
			ART UNIT 3711	PAPER NUMBER PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DOUGLAS G. GUENTHER, KEVIN L. KRYSIAK,  
and KEVIN J. MURPHY

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Application 10/625,325  
Technology Center 3700

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Mailed: December 5, 2008

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*Before* HARRY HORTON, *Discipline Team Paralegal.*  
HORTON, *Discipline Team Paralegal.*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 30, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

**APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER**

Appellants filed an Appeal Brief dated December 12, 2007. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters.< While reference to page and line number of the specification \*\*>requires< somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. >For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on page 5 of the Appeal Brief filed December 12, 2007 is deficient because it does not separately map independent claim 1 to the specification. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

**EXAMINER'S ANSWER, GROUNDS OF REJECTION**

A review of the file indicates that the Examiner's Answer filed April 4, 2008 does not comply with the guidelines provided in MPEP § 1207.02 because it refers, either directly or indirectly, to a prior Office action *without fully restating the point relied upon in the answer.* (See Answer at page 2.) If there is a complete and thorough development of the issues in a prior action, the Examiner may copy any referenced prior rejection(s) from the prior Office action into the Examiner's Answer. The Examiner is reminded to reevaluate his or her prior position in light of the arguments presented in the Brief, and should expressly withdraw any rejections not adhered to in the "Grounds of Rejection Withdrawn" section of the Examiner's Answer.

Therefore, a substitute Examiner's Answer which fully restates any prior points relied upon in the Answer, is required. *See also Manual of Patent Examining Procedure (MPEP) § 1207.02 (8<sup>th</sup> ed. Rev. 7, Sep. 2008) for details.*

TERMINAL DISCLAIMER

Appellants filed a Terminal Disclaimer dated September 16, 2006. There is no indication on the record that the Technology Center (TC) Paralegal has considered the above noted Terminal Disclaimer.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed December 12, 2007 defective, as required by 37 C.F.R. § 41.37(d) (2007);
- 2) to notify the Appellants to submit a “paper” which corrects the Appeal Brief’s Summary of Claimed Subject Matter under 37 C.F.R. § 41.37(c)(1)(v) (2007);
- 3) to acknowledge and consider any “paper” submitted by Appellants to correct the Appeal Brief;
- 4) to vacate the Examiner’s Answer mailed April 4, 2008;
- 5) to generate a new Examiner’s Answer which does not refer directly or indirectly to a prior Office action without fully restating the point relied on in the answer;
- 6) to consider the Terminal Disclaimer filed September 16, 2008 as required; and
- 7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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